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32

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10/024,544	12/21/2001	Masashi Nakashita	2038-282	3584

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/024,544	NAKASHITA, MASASHI
	Examiner Karin M. Reichle	Art Unit 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 19 May 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 December 2001 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

### *Election/Restrictions*

1. Applicant's election with traverse (Group II) and without traverse (Group III) of Group I in the reply filed on 5-19-04 is acknowledged. The traversal is on the ground(s) that 1) the inventions are not combination and subcombination because they are both drawn to body fluid wearing articles as evidenced by their preambles, 2) the subcombination of Group I does not have separate utility and 3) the classification of the Group(s) is unclear, is inaccurate/incomplete as evidenced by the PTO-892 and the differing searches do not impose a serious burden on the Examiner as evidenced by the PTO 892. This is not found persuasive because: 1) Note page 1, lines 5-7 of the instant specification, i.e. the terminology "body fluid wearing article" of the claim preambles may include a myriad of articles including combinations and subcombinations. Furthermore, all the claimed specifics of the groups of claims, i.e. the claim body as well, not just the preamble, must be evaluated to determine whether the Group I claims and the Group II claims are a subcombination and combination which are distinct from each other. As set forth in the restriction, the requirements (1) and (2) have been shown, i.e. the combination does not require specifics of the subcombination and the subcombination has separate utility, see following discussion. 2) Group II can not always be used in the same manner because Group II does not require all the specifics of Group I, e.g., compressive restoring elasticity, e.g. shock absorbing. 3) The Groups have different classification because, e.g., Claim 1 requires the first subpanel or layer to have protuberant portions extending from the flat portion, i.e. discontinuous areas of compression as disclosed, i.e. embossments, whereas

Claim 6 does not, i.e. claimed structures different. Furthermore the classifications of the references in the classification column of the PTO-892 reflect one classification of another reference and does not necessarily identify the subclasses within which the instant claim groups will be classified nor does the 892 evidence the burden imposed to search the different groups of claims and to determine the applicability of each reference in such search with regard to each of the various groups of claims. It is further noted that the Examiner is unaware of any requirement to set forth more than one class and subclass applicable to each Group of claims in the requirement for restriction. Finally, it is also noted with regard to the burden imposed that only the claims 1-5 were presented prior to the first Office action, i.e. only claims 1-5 of different scope were previously searched. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 6-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5-19-04.

3. Claims 16-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5-19-04.

***Specification***

4. The amendments to the claims filed 1-23-04 were not entered because they did not comply with 37 CFR 1.121.

***Drawings***

5. The drawings were received on 5-17-04. These drawings are not approved by the Examiner. The proposed Figure 1 and originally filed Figures 2-4 still do not show the increasing density of the first subpanel in combination with the higher density of the second subpanel as now claimed. Proposed Figures 5-6 also do not show such. Also, Figure 5 as proposed shows wall portions 5c connected to each side of each protuberance but shows the wall portions extending diagonally to the left differently than those extending diagonally to the right, e.g. the former is shown by a light partial line at the point where the wall meets the protuberance whereas the latter is shown by a solid dark line at the meeting point. This difference is not disclosed by the originally filed specification.

6. The drawings are objected to because the cross sectional lines A-A and B-B should be denoted by Roman or Arabic numerals as set forth at page 5, lines 6 and 8. Also, complete and consistent Figures 5 and 6, see discussion supra, should be provided, note the paragraph at page 7, line 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of the increasing density of the first subpanel and a second subpanel of greater density than the first subpanel as claimed in claims 1-5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement

Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Description***

8. The disclosure is objected to because of the following informalities: 1) In the amendment to page 4, line 1, line 2 thereof, "protuberant portions" should be --wall portions--. 2) In the amendment to page 5, line 6, line 6, "3" should be --2,3--.

Appropriate correction is required.

9. The amendment filed 1-23-04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendments to page 3, line 10, page 17, line 12, the abstract and claims 1-5 delete all disclosures of the invention including a first subpanel having a fiber density which progressively increases toward the second subpanel in combination with the other features. Note MPEP 2163.03 and 2163.05. Also note the disclosure at, e.g., page 3, lines 2-5 and last paragraph as originally filed, the paragraph at, e.g., page 17, line 12 as originally filed which discloses such progressively increasing fiber density of the first subpanel is part of a "unique" arrangement (Note "unique" as defined by the dictionary is "being the only one of its kind; sole") ensuring rapid transfer of body fluid, and page 7, line 14-page 8, line 10 as originally filed, i.e. capillary effects of the first subpanel cause smooth, i.e. progressive, transfer of body

fluids. Where is the support in the originally filed specification for the invention as now disclosed? For example, where is it originally disclosed that a first subpanel which does not have such a progressively increasing fiber density is a “unique” arrangement ensuring rapid transfer of body fluids as now disclosed? Provides smooth transfer?

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

10. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the discussion of objection in paragraph 8. It is noted that in addition to the changes to the claim language, the amendments to the description affect the interpretation of the claimed first subpanel density.

11. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the language of line 3, i.e. “comprises”, and line 4, i.e. “0...wt%”, are inconsistent, i.e. does the second subpanel included superabsorbent or not?

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwood '986 in view of Hsieh et al '155 and Chen et al '377.

With regard to claims 1-2 and 4-5, see Figures, col. 1, lines 50-62, col. 2, line 12-col. 3, line 54, col. 3, lines 68-74, i.e. the topsheet is 11, the panel is at least 16 and 18, the first subpanel is 16 and the second subpanel is at least 18, the first subpanel flat portion is 16 between 32 on the topsheet facing side of 16, the protuberances are 32, wall portions are 40, see both Figures 2-4, the fiber density of the first subpanel increases towards the second subpanel, see not only col. 3, lines 26-33 but also col. 3, lines 1-10 and col. 2, lines 26-28 and 42-47 (note that the claims now only require the fiber density increase toward the second subpanel, i.e. doesn't require a progressive increase, an increase from surface to surface of the first subpanel or that the density only increase and that the density of the areas 34 is higher than that of the surface of 40 or 42 adjacent the topsheet 16), and the second subpanel 28 includes no superabsorbent which as best understood meets the limitation of claim 5. The Harwood device therefore includes all the claimed structure except for 1) a backsheet and compressive restoring elasticity as claimed in claim 1 and 30 wt% or less of cellulose as claimed in claim 4 and 2) the density of the second sub panel being higher than that of the first subpanel. However, with regard to 1) see Hsieh et al, Figures, col. 3, lines 31-45, col. 3, line 61-col. 4, line 5, col. 5, lines 8-14, col. 7, lines 16-20, i.e. sanitary napkin with two subpanels, one subpanel having embossments, which one subpanel can be cellulosics or thermoplastic synthetic resin fiber and be any thickness such that the panel is

resistant to wet collapse when simultaneously subjected to compressive forces and fluid, i.e. has a "compressive restoring elasticity" (see also paragraph bridging pages 10-11 of the instant application) and sanitary napkins typically or commonly include backsheets. To make the first subpanel of any number of cellulosic sheets as taught by Harwood a first subpanel of hydrophilic thermoplastic synthetic resin fiber and a thickness such that the panel is resistant to wet collapse instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Hseih et al. With regard to claim 4, it is noted that the claim does not require any cellulose fiber, i.e. can be all synthetic as taught by Hseih et al. Furthermore, to employ a backsheet as taught by Hseih on the Harwood sanitary napkin would be obvious to one of ordinary skill in the art in view of the recognition that such is typically employed on a sanitary napkin and the desire of Harwood to use known components, see, e.g., col. 1, lines 6-8. With regard to 2), see col. 2, lines 19-36 of Harwood, i.e. the desire to promote migration from the first panel 16 to the second panel 18, and compare claims 1 and 3, a second subpanel of lower density is not required. It is also noted that it is not claimed that the density of the second subpanel is uniform or is only higher than that of the first subpanel. See also, e.g., Figures 2 or 13, col. 27, lines 10-11, col. 27, line 54-col. 28, line 3 and col. 38, lines 27-46 of Chen et al, i.e. second subpanel in contact with protrusions of first subpanel has higher density to promote migration of fluids therebetween. To employ a second subpanel having a higher density than the first subpanel as taught by Chen et al on the Harwood device would be obvious to one of ordinary skill in the art in view of the recognition that such would promote migration of fluids therebetween and the desire of Harwood for such migration. In regard to claim 3, Applicants claim specific densities of the second subpanel in combination with those of the flat portion and

those of the protuberant portions and wall portions. Note col. 38, lines 32 and 33 of Chen et al, i.e. the density of the first subpanel would be less than or about 0.2 g/cc. The prior art combination teaches a compression resistant first subpanel in which the flat portion has a lower fiber density than that of the protuberant portions and the wall portions, a first subpanel with an increasing fiber density toward the second sub panel and a second subpanel having a density higher than that of the first subpanel to promote migration of body fluid in the z-direction rather than the lateral direction, see discussion supra. Since the general conditions of claim 3 are disclosed in the prior art it is not inventive to discover the optimum or workable ranges, i.e. the specific densities claimed in claim 3, by routine experimentation, see In re Allen et al, 105 USPQ 233.

#### *Response to Arguments*

14. Applicant's remarks with regard to matters of form on pages 15-16 of the 1-23-04 response have been noted but are either deemed not persuasive for the reasons set forth supra or are deemed moot in that they have not been repeated. Applicant's remarks on pages 17-19 of the 1-23-04 response with respect to withdrawn claims 6-20 have been noted. Applicant's remarks with regard to claims 1-5 on pages 16-17 of the 1-23-04 response have been noted but are deemed not persuasive in that such are narrower than the prior art rejection supra which teaches the now claimed density of the second subpanel and narrower than the claim language and the teachings of Harwood which reference teaches a first subpanel having a fiber density increasing toward the second subpanel, see prior art rejection supra.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other references also teach a subpanel with flat and protuberant portions.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to the specification and claim 1, and thereby claims 2-5.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (703) 308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 308-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Karin M. Reichle*  
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Art Unit 3761

KMR  
August 17, 2004